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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,547	06/05/2001	Dan Kikinis	007287.00008	6896
22907	7590	09/26/2007	EXAMINER	
BANNER & WITCOFF, LTD. 1100-13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				SALTARELLI, DOMINIC D
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/875,547	KIKINIS, DAN
	Examiner Dominic D. Saltarelli	Art Unit 2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 August 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,4-8,11-15 and 18-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,4-8,11-15 and 18-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 6, 2007 has been entered.

### *Response to Arguments*

2. Applicant's arguments with respect to claims 1, 4-8, 11-15, and 18-24 have been considered but are moot in view of the new grounds of rejection.
3. Applicant's arguments regarding claim 25 have been fully considered but they are not persuasive.

Applicant argues that since Hassell's 'transfer' button is on a remote control, there would be no motivation to include such a key on the control panel of a set top box (applicant's remarks, page 7).

In response, the motivation to place such a key on the control panel, as stated, has always been the fact that remote controls are, by themselves easily misplaced. Hendricks is provided as factual support that it is well known to place the same user interface means found on such remote controls on set top box control panels as well.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 4-8, 11-15, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al. (US 2004/0128685 A1, of record) [Hassell] in view of Shintani (5,668,591).

Regarding claims 1, 8, and 15, Hassell discloses a method (and corresponding system) comprising:

displaying an electronic programming guide (figs. 5a-b);  
receiving, at a set to box (STB), input corresponding to an actuation of a command and transferring a program from a first storage device of the STB to a second storage device (see the last sentence of paragraph 9) in response to the actuation (paragraphs 19-21, and 81, wherein actuation of the "transfer" key causes the system to transfer a selected program to another volume, where the first and second storage devices [volumes] consist of removable discs, see paragraph 89).

Hassell fails to disclose the actuation includes a single pressing of a selected portion of a personal digital assistant.

In an analogous art, Shintani teaches using a personal digital assistant to transmit commands to a set top box (cable box 1), where using such a type of intelligent remote control unit also allows a user to engage in more interactive functions (col. 3, lines 16-36).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method, machine readable medium, and system disclosed by Hassell to use a personal digital assistant as the associated remote control [would thus include the disclosed "transfer" key as found on the remote control disclosed by Hassell], as taught by Shintani, providing the benefit of allowing a user to engage in more interactive functions, like games, home shopping, banking, and the like.

Regarding claims 4, 11, and 18, Hassell and Shintani disclose the method, machine readable medium, and system of claims 1, 8, and 15, wherein in response to a second input corresponding to a second actuation of a second command, transferring the program from the second storage device to the first storage device of the STB, wherein the second actuation corresponds to a pressing of a second portion of the personal digital assistant (a user is provided with the means to transfer programs between volumes at will using the "transfer" key, see paragraphs 9 and 81).

Regarding claims 5, 12, and 19, Hassell and Shintani disclose the method, machine readable medium, and system of claims 4, 11, and 18, and further discloses maintaining an index of programs and related auxiliary data transferred from the first storage device to the second storage device (paragraphs 85-86).

Regarding claims 6, 13, and 20, Hassell and Shintani disclose the method, machine readable medium, and system of claims 5, 12, and 19, wherein the second storage device is a removable storage device (paragraph 85), and in response to a user selecting the program transferred on to the removable storage device, the STB prompts for the insertion of the removable storage device into the STB (paragraph 89).

Regarding claims 7, 14, and 21, Hassell and Shintani disclose the method, machine readable medium, and system of claims 6, 14, and 20, wherein the removable storage device is a DVD-RAM (paragraph 20).

Regarding claim 22, Hassell and Shintani disclose the method of claim 4, wherein the second actuation corresponds to a single pressing of a transfer function button on the remote control (the personal digital assistant is the remote control, see Shintani, col. 3, lines 16-36).

Regarding claim 23, Hassell and Shintani disclose the method of claim 4, wherein the first portion and the second portion are the same portion (the 'transfer' key is the common portion used in transferring programs from one location to another, see Hassell, paragraph 81).

Regarding claim 24, Hassell and Shintani disclose the system of claim 15, wherein Hassell discloses the STB to include a tuner (to perform the channel tuning operation, paragraph 19); a signal input (fig. 2, input 26); a storage medium (fig. 2, digital storage device 31); a processor (an inherent feature of the disclosed STB, which is necessary to control the operations ascribed to the STB); a digital video encoder and decoder (the encoder for converting the program to a desired format, see paragraph 82, where the destination for storage is a digital medium, see paragraph 85, and the decoder for outputting program content to a television, see paragraph 22); and a digital output port (for outputting digital signals on a digital bus, see paragraph 19).

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell in view of Hendricks et al. (5,559,549, of record) [Hendricks].

Regarding claim 25, Hassell discloses a method comprising:  
displaying an electronic programming guide (figs. 5a-b);  
receiving, at a set to box (STB), input corresponding to an actuation of a command and transferring a program from a first storage device of the STB to a

removable storage device (see the last sentence of paragraph 9) in response to the actuation (paragraphs 19-21, and 81, wherein actuation of the "transfer" key causes the system to transfer a selected program to another volume, where the first and second storage devices [volumes] consist of removable discs, see paragraph 89).

Hassell fails to disclose the actuation includes a single pressing of a selected portion of a control panel of the STB.

In an analogous art, Hendricks discloses using a control panel on a STB to access menus and provide user input, as having access to the same input feature on a control panel as a remote control allows a user to interact with the STB even if the remote control is misplaced (col. 6, lines 38-46).

it would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hassell to include a control panel for receiving the user input on the STB, as taught by Hendricks, for the benefit of providing a user interface means which is always available to the user, negating full reliance upon remote controls which are often lost or misplaced.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DS

*Donie Satoru*